

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert Davidson Examiner: James R. Sheleheda
Serial No.: 09/760,242 Group Art Unit: 2614
Filed: January 12, 2001 Docket No.: 10002343-1 (H303.200.101)
Due Date: December 8, 2005
Title: PERSONAL MOVIE STORAGE MODULE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

Please consider the following remarks during the Pre-Appeal Brief Conference.

Claim Rejections under 35 U.S.C. §103

Independent claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone, U.S. Patent No. 5,734,781 ("Cantone") in view of Chung, U.S. Patent No. 6,628,963 ("Chung"), and the Jamie Beckett article entitled "Making Room for Digital Data" ("Beckett"). Independent claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Chung, Beckett, and Yamagata et al., U.S. Patent No. 5,908,793 ("Yamagata"). Independent claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cantone in view of Chung, Beckett, Yamagata, and Allen, U.S. Patent No. 5,909,638 ("Allen").

Applicant submits that independent claim 1 is not taught or suggested by Cantone, Chung, and Beckett, either alone, or in combination. The Examiner admits that Cantone fails to disclose the limitations of claim 1 of a portable digitally formatted playback device, displaying the movie on the portable digitally formatted playback device, and wherein said storage module includes an ARS memory. (Office action mailed Sept. 8, 2005, page 2).

Moreover, Cantone teaches away from a combination with Chung. Cantone discloses that the invention plays back the stored digitized data in analog format via a conventional VCR to forego the necessity of customized playback equipment. (Cantone, col. 2, lines 34-37). Cantone discloses transforming analog data via a tape loop from a VCR-sized cassette to a conventional VCR machine capable of reading the analog data.

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Amendment and Response under 37 C.F.R. 1.116

Applicant: Robert Davidson

Serial No.: 09/760,242

Filed: January 12, 2001

Docket No.: 10002343-1

Title: PERSONAL MOVIE STORAGE MODULE

Chung discloses a customized portable multimedia player including a portable phone section having a modem adapted to communicate with an external device. A multimedia control section is adapted to perform a control of the overall operation of the portable multimedia player and includes a CPU, a control logic circuit, a memory having a predetermined storage capacity that stores a music file and a moving picture file downloaded by way of online communications, and a system ROM adapted to store a predetermined control program. A CD player section drives a CD-ROM driver to reproduce a CD media. A key input section has a plurality of function keys and is adapted to input a control signal for controlling each of the elements of the portable multimedia player. A MPEG data processing section processes a MPEG-1 video signal and a MP3 audio signal into an analog signal to output the converted signal to the outside. An image outputting section displays a video signal applied thereto from the MPEG data processing section and multimedia information of current status on a LCD screen. An audio codec mixing section outputs the audio signal applied from the MPEG data processing section as a stereo audio signal to the outside through a voice outputting section. (Abstract).

There is no teaching or suggestion in the cited references for one skilled in the art to combine the digital videocassette of Cantone designed to be used with a conventional VCR with the complex, customized portable multimedia player of Chung.

In addition, Beckett is cited for teaching the concept of ARS. At the time of Beckett, however, as stated in the publication, ARS was in the early stages of development and was only a **potential** technology. (Beckett, page 1, para. 3, and page 2, para. 2). Therefore, one skilled in the art would not look to Beckett for using ARS in a new device, since according to Beckett, ARS was still only in the early stages of development and not an available technology for replacing conventional memory at the time of Beckett.

In view of the above, Applicant respectfully submits that the rejection of claim 1 under 35 U.S.C. §103(a) should be withdrawn. Dependent claims 2-8, 19, and 20 further define patentably distinct independent claim 1. Accordingly, these dependent claims are also believed to be allowable over the cited references. Therefore, withdrawal of the rejections and allowance of claims 1-8, 19, and 20 is respectfully requested.

Applicant submits that independent claim 9 is also not taught or suggested by Cantone, Chung, Beckett, and Yamagata, either alone, or in combination. The Examiner

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Serial No.: 09/760,242

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Docket No.: 10002343-1

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admits that Cantone fails to disclose a portable digital playback device capable of displaying a digitally formatted movie and including an atomic resolution storage device memory component and a communication interface for communicating to and from the memory components of the storage module and for providing the digitally formatted movie from the storage module to the portable digital playback device. (Office action mailed Sept. 8, 2005, page 7).

Yamagata discloses an information recording and reproducing apparatus comprising a 3½ inch hard disk drive, a semiconductor memory connected to the 3½ inch hard disk drive for exchanging data, and a battery used to transfer data in the semiconductor memory to the 3½ inch hard disk drive when a power supply is shut off, all of which are accommodated in a housing of the same outer dimension as that of a 5¼ inch floppy disk drive. The information recording and reproducing apparatus is replaceable with a conventional floppy disk drive. (Abstract).

Yamagata discloses a disk drive for replacing a conventional floppy disk drive. The disk drive of Yamagata is **not** a portable storage module as required by the limitations of claim 9. Furthermore, there is no teaching or suggestion in Yamagata or any of the other cited references for one skilled in the art to combine a typical communication interface from the non-portable disk drive of Yamagata with the digital videocassette of Cantone, the multimedia player of Chung, and the ARS memory of Beckett and arrive at the invention recited by claim 9. For these reasons and for the same reasons as discussed above with reference to claim 1, Applicant respectfully submits that Cantone, Chung, Beckett, and Yamagata, either alone, or in combination, fail to teach or suggest the invention as recited by independent claim 9.

In view of the above, Applicant respectfully submits that the rejection of claim 9 under 35 U.S.C. §103(a) should be withdrawn. Dependent claims 10-15 further define patentably distinct independent claim 9. Accordingly, these dependent claims are also believed to be allowable over the cited references. Therefore, withdrawal of the rejections and allowance of claims 9-15 is respectfully requested.

Applicant submits that independent claim 16 is not taught or suggested by Cantone, Chung, Beckett, Yamagata, and Allen, either alone, or in combination. The Examiner admits that Cantone fails to disclose the playback device displays the digitally formatted movies; the

Amendment and Response under 37 C.F.R. 1.116

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Serial No.: 09/760,242

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Docket No.: 10002343-1

Title: PERSONAL MOVIE STORAGE MODULE

storage module includes an atomic resolution storage device; a communication interface for communicating to and from the storage device and for providing at least one digitally formatted movie from the storage module; a system further permitting purchasable access to digitally formatted movies, a centralized movie database for downloading to multiple points of purchase; and a point-of-purchase center for selectively transferring a copy of a selected movie to the movie storage module.

Allen discloses that the selected movie is retrieved from local cache storage or downloaded from a central distribution site for manufacturing onto a blank or reused videotape. One feature of the system is the ability to write a two-hour videotape in Standard Play (SP) mode using a compressed MPEG-2 format to store an entire movie into approximately four gigabytes of storage. The movie data file can be downloaded from the central site to the remote manufacturing site and written onto standard VHS tape using a parallel decompression engine to write the entire movie at high speeds onto a standard VHS tape in approximately three minutes. (Col. 3, lines 37-48).

Allen fails to disclose transferring a copy of a movie from the centralized database to the memory device of the movie storage module as recited in claim 16. In contrast, Allen discloses writing the movie onto a standard VHS tape. Furthermore, there is no teaching or suggestion in Allen or any of the other cited references for one skilled in the art to combine the method of writing a movie to a standard VHS tape of Allen with the digital videocassette of Cantone, the multimedia player of Chung, the typical communication interface from the non-portable disk drive of Yamagata, and the ARS memory of Beckett and arrive at the invention recited by claim 16. For these reasons and for the same reasons as discussed above with reference to claims 1 and 9, Applicant respectfully submits that Cantone, Chung, Beckett, Yamagata, and Allen, either alone, or in combination, fail to teach or suggest the invention as recited by independent claim 16.

In view of the above, Applicant respectfully submits that the rejection of claim 16 under 35 U.S.C. §103(a) should be withdrawn. Dependent claims 17 and 18 further define patentably distinct independent claim 16. Accordingly, these dependent claims are also believed to be allowable over the cited references. Therefore, withdrawal of the rejections and allowance of claims 16-18 is respectfully requested.

Amendment and Response under 37 C.F.R. 1.116

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Title: PERSONAL MOVIE STORAGE MODULE

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Request should be directed to either Philip Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332 or Patrick G. Billig at Telephone No. (612) 573-2003, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

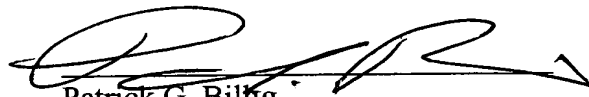
Respectfully submitted,

Robert Davidson

By his attorneys,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5 day of December, 2005.

By 
Name: Patrick G. Billig